

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Norbert Heske, et al.) Group: 3736
Serial No.: 10/500,522)
Filed: April 6, 2005)
Title: BIOPSY DEVICE FOR REMOVING TISSUE)
SPECIMENS USING A VACUUM) Examiner: E. Lloyd

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

MS Amendment
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Responsive to the election/restriction requirement in the Office Action dated March 31, 2009, Applicants hereby elect with traverse the invention recited in Group E, claims 96, and 111-115, directed to tension slide placed in a cocked position, in the above-identified application.

The Examiner has indicated that claim 96 is generic to all of the figures shown in the drawings of the present application, but that the subject matter of claim 96 does not define over the contribution of the prior art, namely, U. S. Patent No. 4,989,614 (Dejter, Jr. et al.) Applicants respectfully disagree.

Applicants' representative thanks the Examiner for the courtesies extended during the in-person interview conducted on May 28, 2009, in which the present election/restriction requirement, and in particular, claim 96 and Dejter, Jr. et al., were discussed. No final agreement was reached during the interview.

Applicants respectfully submit that independent claim 96 is generic to all claims in the present application, and is not anticipated or rendered obvious by Dejter, Jr. et al.

Claim 96 recites:

A biopsy device for taking tissue samples, comprising:

a housing containing an electric power source and a tension slide connected to the power source, wherein the tension slide is brought into a cocked position against the action of a spring by the power source;

a removable element configured for insertion into the housing, comprising

a biopsy needle unit, comprising a hollow biopsy needle, having a sample removal chamber, and a cutting sheath, wherein the biopsy needle unit is arranged on the tension slide;

a vacuum pressure-generating device; and

a connection element connecting the biopsy needle unit and the vacuum pressure-generating device; and

a control panel attached to the housing.

It is respectfully submitted that Dejter, Jr. et al. does not disclose, teach, or suggest a cutting sheath and/or does not disclose, teach or suggest a tension slide brought into a cocked position against the action of a spring by the power source, and thus does not anticipate or render obvious claim 96.

The Examiner identifies sheath 6 of Dejter, Jr. et al. has corresponding to the recited cutting sheath. However, the sheath 6 of Dejter, Jr. et al. is only used to support needle 2 and

stylet 3, and is not used as a cutter. Sheath 6 includes a finger guard 13, or a sheath handle 14, to assist the operator in manipulating the tip of the sheath. (Dejter, Jr. et al. col. 8, ll. 56-66). In addition, the cutting/collection of cells occurs by the reciprocation of the needle 2 within a target area, with only the aid of vacuum (see, e.g., Dejter, Jr. et al. col. 7, ll. 26-46). Thus, Dejter, Jr. et al. does not disclose, teach or suggest a cutting sheath, as recited in claim 96.

Further, while Dejter, Jr. et al. discloses a mechanism by which the needle is reciprocated, it is respectfully submitted that such does not constitute “a tension slide connected to the power source, wherein the tension slide is brought into a cocked position against the action of a spring by the power source”. The term “cocked” in the present specification refers to a locking of the tension slide. (See Applicants’ specification at paragraph 0072). In contrast, assuming arguendo that Dejter, Jr. et al. discloses a tension slide, there is no locking (cocking) of the slide against the action of a spring, but rather Dejter, Jr. et al. discloses a reciprocation by the activation and deactivation of the solenoid 70. (See, e.g., Dejter, Jr. et al. col. 14, ll. 33-38). Thus, Dejter, Jr. et al. does not disclose, teach or suggest a tension slide connected to the power source, wherein the tension slide is brought into a cocked position against the action of a spring by the power source, as recited in claim 96.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claim 96 is not anticipated or rendered obvious by Dejter, Jr. et al., and that claim 96 is generic to all alleged species. Accordingly, it is respectfully requested that the

election/restriction requirement be withdrawn, and that the prosecution of all claims 96-143 proceed on their merits in view of the allowability of generic claim 96 over Dejter, Jr. et al.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any questions concerning the foregoing arise, the Examiner is invited to contact the undersigned at (317) 894-0801.

Respectfully submitted,
/Ronald K. Aust, Reg. No. 36735/
Ronald K. Aust
Registration No. 36,735

Attorney for Applicants

RKA/ts

TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

Electronically Filed: May 29, 2009